

ESTTA Tracking number: **ESTTA703379**

Filing date: **10/20/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204897
Party	Defendant Laguna Lakes Community Association, Inc.
Correspondence Address	DONNA M FLAMMANG BRENNAN MANNA & DIAMOND PL 3301 BONITA BEACH RD BONITA SPRINGS, FL 34134-7833 UNITED STATES dmflammang@bmdpl.com, crothschild@bmdllc.com, wsharders@bmdllc.com
Submission	Opposition/Response to Motion
Filer's Name	Chad R. Rothschild
Filer's e-mail	crothschild@bmdllc.com
Signature	/s/ Chad R. Rothschild
Date	10/20/2015
Attachments	Response to Motion for Leave to Conform Pleadings to Evidence.pdf(21005 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

John Gerard Marino,)	
)	Consolidated Opp. No. 91/204,897
)	91/204,941
Opposer,)	
)	
v.)	<u>RESPONSE TO OPPOSER'S</u>
)	<u>MOTION FOR LEAVE TO</u>
Laguna Lakes Community Association,)	<u>CONFORM PLEADINGS TO</u>
Inc.,)	<u>EVIDENCE</u>
)	
Applicant.)	

On October 5, 2015, in connection with his reply trial brief, Opposer, John Gerard Marino, filed a conclusory, unsupported motion for leave to conform pleadings to the evidence under TBMP § 507.03(a). In support of that motion, all Opposer contends is that:

allowing [Opposer] to argue ornamentality as part of his priority argument, will serve the interests of justice. Moreover, [Applicant] can't demonstrate any prejudice in that these very issues have already been addressed by the extensive discovery in this matter.

To the contrary, the issue of ornamentality was never raised as an issue until Opposer filed his trial brief. As the moving party, Opposer generally bears the burden with his motion for leave to conform the pleadings to the evidence of demonstrating how the presentation of the merits of this case will be served. *See* TBMP § 507.03(a). Here, Opposer has failed to set forth any arguments, evidence, or other reasons demonstrating how the presentation of the merits will be served or why the motion should be granted.

Ornamentality is a ground for opposition that is separate from likelihood of confusion, descriptiveness, primarily geographically descriptive – those actually pled and tried by Opposer. *Compare* TBMP § 309.03(c)(8) (concerning ornamentality) with TBMP § 309.03(c)(1) (likelihood of confusion) and § 309.03(c)(2)-(3) (descriptiveness and primarily geographically

descriptive); *see also Wagner Spray Tech Corp. v. Graco, Inc.*, Opposition No. 91/125, 525, 2003 WL 21716218 at *1 (TTAB 2003) (“The pleaded grounds for this opposition are that the color blue is an “ornamental feature” of the goods and does not function to identify the source of the goods in connection with which applicant seeks to register it . . .”). Neither notice of opposition filed by Opposer on April 25, 2012 and August 28, 2012, respectively, lists ornamentality as a ground for opposition. The same is true with respect to the amended notices of opposition that Opposer filed on August 2, 2012.

What Opposer seeks to do is impermissibly add a ground for opposition that was never litigated, and on which no discovery was taken. Applicant’s discovery and litigation strategy revolved around the amended notices of opposition that were pled in this case. Ornamentality was never pled, and was never brought up as an issue. Opposer points to no discovery that was undertaken, and no trial testimony elicited, on the unpled ground for opposition of ornamentality. The rule contemplates that there is “evidence which was the subject of the objection” that the pleadings should conform to. TBMP § 507.03(a). Here, there is no evidence to conform Opposer’s request to. As such, Applicant would be severely prejudiced in maintaining its defense on the merits on this point, as this is simply not an issue in the case.

Accordingly, for each and every reason set forth herein, and for all of them taken together, Opposer’s motion for leave to conform the pleadings to the evidence should be denied. In the alternative, though the motion should be denied, in the event that it is granted, pursuant to TBMP § 507.03(a), Applicant respectfully requests that its testimony period be reopened for the purpose of addressing and briefing the issue of ornamentality.

Respectfully submitted,

/s/ Chad R. Rothschild

W. Scott Harders (Ohio Bar No. 0070598)
Donna M. Flammang (Florida Bar No. 0015230)
Chad R. Rothschild (Ohio Bar No. 0088122)

Brennan, Manna & Diamond, LLC

75 East Market Street

Akron, Ohio 44308

Phone: 330-253-3715

Fax: 330-253-3745

wsharders@bmdllc.com

dmflammang@bmdpl.com

crothschild@bmdllc.com

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that on the 20th day of October, 2015 a copy of the foregoing was served by e-mail upon:

Scott Behren, Esq.
Behren Law Firm
2893 Executive Park Drive Suite 203
Weston, FL 33331
scott@behrenlaw.com; scott.behren@gmail.com

/s/ Chad R. Rothschild

One of the Attorneys for Applicant